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In re Application of EGELAND et al
U.S. Application No.: 10/574,818
PCT Application No.: PCT/GB2004/004390
Int. Filing Date: 15 October 2004
Priority Date Claimed: 15 October 2003
Attorney Docket No.: 2006_0521A
For: ELECTROCHEMICAL TREATMENT OF
SUBSTRATES

DECISION

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(b)" filed 29 August 2007.

BACKGROUND

On 15 October 2004, applicant filed international application PCT/GB2004/004390, which claimed priority of an earlier United Kingdom application filed 15 October 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 28 April 2005. The thirty-month period for paying the basic national fee in the United States expired on 15 April 2006.

On 06 April 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 21 December 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 20 June 2007, applicant filed a petition under 37 CFR 1.47(b).

On 29 June 2007, this Office mailed a decision dismissing the 20 June 2007 petition.

On 29 August 2007, applicant filed the present renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (3), (4), and (6) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that the sole inventor Ryan Egeland refuses to sign the application papers. Petitioner has adequately demonstrated that a bona fide attempt was made to present a copy of the application papers to Dr. Egeland for signature (see supplemental affidavit of Michael Bennett, ¶3). Furthermore, the petition contains sufficient evidence of Dr. Egeland's refusal to cooperate. In particular, Dr. Egeland has failed to respond to repeated telephone and electronic mail messages, has apparently refused to accept delivery of correspondence mailed to him, and has apparently avoided personal contact with an investigator (see original Bennett affidavit). Thus, it can be concluded with reasonable certainty that Dr. Egeland refuses to join in the application.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, the petition states that Dr. Egeland agreed in writing to assign the invention to Oxford Gene Technology IP Limited ("OGT"). Petitioner has provided a copy of an agreement signed by Dr. Egeland which grants OGT the exclusive ownership of intellectual property which is the result of work performed by Dr. Egeland during his employment with OGT (see Exhibit 1). Furthermore, petitioner has adequately illustrated that the present invention was made during and contributed to OGT while Dr. Egeland was employed by OGT (see affidavit of Peter Hotten, ¶3, and affidavit of Edwin Southern, ¶4.) Thus, it would be reasonable to conclude that OGT has sufficient proprietary interest in the present application.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(b) is GRANTED.

This application has an international filing date of 15 October 2004 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 20 June 2007.

As set forth in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

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